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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,904	12/13/2001	Hiroyuki Katagiri	U 013774-2	1987

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EXAMINER

LASTRA, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,904

Applicant(s)

KATAGIRI ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 and 19-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13 and 19-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 8-13 and 19-42 have been examined. Application 10/021,904 (METHOD AND SYSTEM FOR PROVIDING ADDITIONAL SERVICES FOR PRODUCTS) has a filing date 12/13/2001 and foreign priority date 12/15/2000.

Response to Amendment

2. In response to Non Final Rejection filed 08/11/2005, the Applicant filed an Amendment on 11/09/2005, which amended claims 8-10, 19-21, cancel claims 14-18 and added new claims 37-42. Applicant's amendment overcame the claim objection rejection. In response to Request for a new action filed 02/17/2006, the Examiner issued a new Final Rejection.

Response to Request for a new action

3. Applicant request for new action filed 04/12/2006 is non compliant. Applicant filed an Affidavit on 11/15/2005 for evidence of commercial success, however, said affidavit was submitted in response to a Non Final Rejection filed 08/11/2005 where all the claims were rejected under a Section 102 rejection. The rule of the MPEP 2131.04 recites that "Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973)". Furthermore, even if the Non Final rejection filed 08/11/05 would had been a 103 rejection, the affidavit filed on 11/15/2005 would still had not been considered, as said affidavit did not compare the evidence of commercial success with the closest prior art (See MPEP 716.01(c) and 2141).

4. Claim 9 is objected to because of the following informalities: Claim 9 recites "bei9ng" on page 4, line 2 when it should recite "being". Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-13 and 19-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woll (US 6,612,501) in view of Applicant's background of the Invention.

As per claims 8-10 and 19-21, Woll teaches:

A system for providing additional services for products, which has functions of attaching added values to products that are distributed in a market and providing additional services based on the added values, the system comprising:

a first identification code generating device, which generates a first identification code (see column 1, lines 49-60);

a second identification code generating device, which generates a second identification code (see column 2, lines 31-64);

a first identification code attaching device, which prints said first identification code to a package of a *first* product that is shipped by a first company (see column 1, lines 25-31), *said first identification code being printed onto a location that will not be visible unless the package of the first product is opened* (see column 6, lines 1-3),

a second identification code attaching device, which prints said second identification code to a package of a *second* product that is shipped by a second company (see column 4, lines 1-13) *different from said first company*. Woll does not expressly mentioned a second company. However, Applicant's background teaches that it is old and well known in the business art to promotes the sales of a product by attaching to said product, in addition to the values that an individual product has inherently, an added value, which is not directly related to the functions of the product. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a second company (i.e. different from a toy company"; see Woll figure 3, item 104) would be motivated to attach an added value (i.e. unique identification code printed on a trading card) to said companies' products for the purpose of promoting the sale of said products.

said second identification code being printed onto a location that will not be visible unless the package of the second product is opened (see column 6, lines 1-3),
and

a service providing device including a Web server to provide a Web page to at *least one* terminal device operated by a user through Internet and to input identification codes from said terminal devices onto the Web page (see column 5, lines 15-24);

wherein said service providing device has a first function to input two different of *said* identification codes separately at the same time or at different times from a user (see column 5, lines 31-40), a second function to confirm that one of *said two* identification codes that have been input is said first identification code and the other is said second identification code and a third function to provide a predetermined service to *said user* under said confirmations that both said first and second identification codes has been input by providing information to said terminal device operated by said user, said second function being carried out by communicating with the first identification code generating device and the second identification code generating device to inquire, (see column 2, lines 1-7; 30-65; column 5, lines 32-40), wherein the first identification code generating device and the second identification code generating device have functions of generating the first identification code and generating the second identification code, respectively, based on a predetermined algorithm (see column 2, lines 10-15) , and

wherein said second function is carried out by performing a confirmation process concerning an input identification code based on said predetermined algorithm (see column 2, lines 1-7; column 5, lines 24-32).

As per claims 11, 22, 25, 28, 31 and 34, Woll teaches:

A system for providing additional services for products as set forth in claim 19, wherein:

when both the first identification code and the second identification code have been input from a user, a content of the service provided by the service providing device

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is changed according to an order of input of the two types of identification code (see column 5, lines 32-40).

As per claims 12, 23, 26, 29, 32 and 35, Woll teaches:

A system for providing additional services for products as set forth in claim 19, wherein:

a plurality of patterns are prepared for one of either or both the first identification code and the second identification code, and a content of the service provided by the service providing device is changed according to a pattern of an identification code that has been input (see column 2, lines 30-64).

As per claims 13, 24, 27, 30, 33 and 36, Woll teaches:

A system for providing additional services for products as set forth in claim 8, wherein: as a service to be provided by the service providing device, a provision of a game, a provision of a quiz, or a provision of fortune-telling information to the user is carried out (see column 2, lines 30-64).

As per claims 37-42, Woll teaches:

A system for providing additional services for products as set forth in claim 8 wherein the second company is not a confection maker (i.e. toy maker; see Woll figure 3, item 104) but does not expressly wherein the first company is a confection maker, however packaging trading card in "other products" (see Woll figure 3, item 104). Therefore, confection makers would be motivated to package Woll's trading card into said confection makers products in order that said trading cards server as an added incentive to buy said confection maker's products.

Response to Arguments

6. Applicant's arguments filed 11/09/2005 have been fully considered but they are not persuasive. The Applicant argues that Woll does not teach "a first identification code attaching device, which prints the first identification code to a package of a first product that is shipped by a first company, said first identification code being printed onto a location that will not be visible unless the package of the first product is opened". The Applicant also argues that the Woll's trading card, on which an ID number is printed is a "product" itself, but in the claimed invention, an ID code is printed on a package at a location where it would not be visible unless the package is opened. The Applicant further argues that the trading card of Woll cannot be opened and the package of the claims is not the "product" trading card of Woll. The Examiner answers that Applicant's specification page 12, lines 27-37 teaches that "a character card or other so-called "freebie" may for example be used as a printed object on which the identification code is printed". Woll teaches in column 5, line 60 – column 6, line 3 the promotion of a product line (i.e. dinosaurs toys) by printing identification codes on trading cards included in said products, where said unique identification codes allow purchasers of said products earn rewards. Also, Woll teaches that the identification code printed on said trading card is not visible in the package, so that the purchaser of said products (i.e. product line of toys) has no way of knowing what card is in the package. Therefore, Woll teaches printing a first identification code (i.e. "unique identification code printed on a trading card") to a package of a first product (i.e. "different dinosaur toys") that is shipped by a first company (i.e. "toy company"), said first identification code being printed onto a

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location that will not visible unless the package of the first product is opened (i.e. purchaser of said toy has no way of knowing what card is in the package"). Also, Woll teaches that the use of a trading card unique code may rendered inoperative for a second user (see Woll column 4, lines 17-30). Therefore, Woll would be motivated to maintain hidden from view the identification code printed on a product (i.e. identification code is printed on a trading card that is attached to a product) in view that said code would become inoperative if used by another user.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

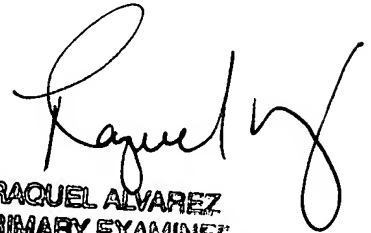
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra
May 3, 2005



RAQUEL ALVAREZ
PRIMARY EXAMINER